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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/667,449
Filing Date: September 23, 2003
Appellant(s): BACKMAN, LINA STRAND

Charles F. Wieland III
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 24 February 2009 appealing from the Office action mailed 13 June 2008.

(1) REAL PARTY IN INTEREST

SCA Hygiene Products AB is the real party in interest, and is the assignee of Application No. 10/667,449.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The grounds of rejection noted by applicant is substantially correct except for the following New Grounds of Rejection.

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement

thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-13 are rejected under 35 U.S.C. § 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC § 101.

Claims 17-20 are rejected under 35 U.S.C. 101 because the limitations recite a system per se which may be equated to that of interconnected devices which is defined by its

physical structural elements and corresponding functionality. No physical structural elements are recited, the claims are directed to non statutory subject matter. The body of the claims comprise software modules, which are virtual modules not physical structures.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2003/0195793 A1	Jain et al.	10-2003
5,676,138	Zawilinski	10-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

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of the claims comprise software modules, which are virtual modules not physical structures.

Claim Rejections - 35 USC § 103

Claims 1-2, 5-7, 10-11, and 14-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Jain et al., US2003/0195793, henceforth known as Jain.

Claims 1-2, 10-11, and 14-18:

- ***Identifying and informing the potential customer of a new product.***
- ***Presenting to potential consumer a visual of a first product.***
- ***Presenting to potential consumer a visual of a similar product.***
- ***Modifying visual of first product to appear like the similar product.***

Jain in at least paragraph [0023 and 0092] discloses the deployment of a computerized marketing research activity tool that adaptively adjusts the number and selection of participants and dynamically adjusts the marketing research activity in a manner that will maximize the value of the information and minimize the cost of the information collected from the participants. Jain does not specifically disclose presenting visual images of a product per se. However, Jain in at least paragraph [0173] discloses the use of product comparisons to personalize the information presented to potential consumers and in Table 2 discloses using an advertisement of a similar product or the new product to determine a potential consumer's inclination to buy the product. Therefore, it

would be obvious, at the time of invention, to one of ordinary skill in the art, to determine that the presentation of an advertisement of the similar product or the new product is equivalent to Applicant's presentation of a visual.

Claims 5-7:

- ***Identifying a panel of people;***
- ***Presenting to a panelist a visual of a first known tangible product.***
- ***Presenting a visual of a second product.***
- ***Presenting an intermediate product with characteristics of first and second product.***
- ***Surveying a panelist on impressions of the products and their associated features.***

Jain in at least paragraph [0001] discloses an invention that automates the design of Marketing Research including one or more research approaches, e.g., marketing experiments, surveys, interviews, focus group discussions and the like. Jain in at least paragraph [0149 and 0173] discloses personalizing the Research Approach Design Tool by modifying the research design, i.e., the experiment, the survey questionnaire to suit an individual customer to maximize the value of the information obtained from a customer. Jain does not specifically disclose presenting visual images of a product per se. However, Jain in at least paragraph [0173] further discloses the use of product comparisons to personalize the information presented to potential consumers and in Table 2 discloses using

an advertisement of a similar product or the new product to determine a potential consumer's inclination to buy the product. Therefore, it would be obvious, at the time of invention, to one of ordinary skill in the art, to determine that the selection of a panel of people is similar to setting up a focus group and the presentation of an advertisement of a similar product or the new product is equivalent to Applicant's presentation of a visual.

Claims 3-4, 8-9, 12-13, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jain as applied to claims 1-2, 10-11, and 17-18 above, and further in view of Zawilinski, US 5,676,138..

Claims 3-4, 8-9, 12-13, and 19-20:

- ***Visual presentation is still images.***
- ***Visual presentation is moving images.***

Zawilinski in at least Column 3, lines 28-62 discloses a computerized multimedia system for measuring, analyzing, storing, and displaying emotional responses elicited by humans when presented a stimulus such as a television commercial. Zawilinski in at least Column 5, lines 63-67 further discloses that the interactive multimedia computer is capable of at least visually displaying one stimulus presented at any given time interval. Zawilinski does not specifically disclose still images per se, however in at least Fig. 2 and Column 6, lines 36-42 discloses a representative screen with the stimulus. Therefore, it would be obvious, at the

time of the invention, to one of ordinary skill to be motivated to combine Jain's marketing research activity with Zawilinski's multimedia stimuli and response analyzer to obtain a better indicator of a customer's response to various products or their features.

(10) Response to Argument

(10a) Claims 1, 2, 5-7, 10, 11 and 14-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jain et al. ("Jain", US Patent Application Publication No 2003/0195793).

Appellant argues in their (a.) Summary and (b.) Claimed Features Absent from Applied Art regarding independent Claims 1, 5, 10 and 17 that Jain ***"It does not involve products, and in particular does not involve a 'first product', a 'second product' or one or more 'intermediate visual presentations' that represent a changed appearance of the first of second product (or both) wherein one of the intermediate images is that of a new product."***

Appellant further argues that the applied art does not teach ***"one or more intermediate visual presentations of at least one of the first and second products by changing the appearance of said at least one characteristic of said first product to more closely resemble said at least one characteristic of said second product"***.

Appellant further argues that the applied art does not teach ***"one of said intermediate visual presentations being an visual presentation of said new product"***.

EXAMINER'S RESPONSE: Jain in paragraphs [0024, 0064 and 0104] clearly articulates the purpose of the invention is for use in Automated Online Design and Analysis of Marketing Research Activity and Data, and uses predefined objectives to include sales forecasting, product preference test, advertising campaign effectiveness studies, new product acceptance and potential, pricing studies, study of business trends, desired feature enhancement to a product, market share analysis, studies of coupons, marketing campaign design, and market structure study to spot new opportunities.

Jain in at least paragraph [0174] and Table 2 further discloses that Customer Joe has missing information (Importance of 2 product attributes) and the approach taken to address that missing information is to collect Joe's response to an advertisement highlighting the two product attributes.

Customer George who is missing information regarding the "Importance of 1 attribute" is presented with an advertisement highlighting the attribute.

Customer Nicholas is missing information regarding his "inclination to buy" and this is addressed by collecting his response to an advertisement of a similar or the new product.

Jain in at least paragraph [0173] further discloses that the research approach may be personalized by focusing on feedback such as from a, comparison with other products etc.

Appellant further argues in their (c.)No Reason to Modify Applied Art *"Thus, the Examiner has not addresses and the applied art does not teach or suggest, and the neither the Examiner nor the applied art or provide reasons to modify the prior art to 'presenting to said potential customers one or more intermediate visual presentations of at least one of the first and second products by changing the appearance of said at least one characteristic of said first product to more closely resemble said at least one characteristic of said second product (as recited in claims 1, 5, 10 and 17), one of said intermediate visual presentations of said new product,' as recited in claim 1 and similar recitation n independent claims 10 and 17. As said before the applied art does not include this combination of recitation, and the Examiner has not squarely addressed them. Hence, the rejection fails the KSR test."*

EXAMINER'S RESPONSE: With regards to the rejection of Claims 1, 5, 10 and 17 the Examiner did not modify the art. In the Response to the Arguments section of the Office Action the Examiner recited after addressing the Appellant's arguments that "Therefore, it would have obvious, at the time of the invention, to one of ordinary skill in the art that product comparisons as disclosed by Jain are conducted by providing the target group (focus group) with models, visual images, multi-media images and similar tangible attributes which the target group can easily grasp the differences in product attributes presented by the marketing research group." The intent of the recitation was to inform Appellant that the marketing research as

disclosed by Jain would have been conducted by one of ordinary skill in the art through the use of focus groups where the focus groups would have been exposed to all the important and tangible attributes of both existing and new products for comparison purposes (Jain paragraph [0173]).

(10b) Dependent Claims 2, 6, 7, 11 and 14-16 and 18

Appellant argues ***“Nor is Jain concerned with presenting an intermediate visual presentation of a new products, where the new product has at least one characteristic of the first known product changed to more closely resemble the at least one characteristic of the second product, as recited in claims 2, 11, and 18.”***

Appellant further argues regarding Jain paragraph [0174] ***“Paragraph [0174] briefly discusses that advertisements may have different value of attributes. However, these attributes are based on a first product. See also Table 2. There is no disclosure that the attributes are changed to more closely resemble attributes of a second product.”***

EXAMINER'S RESPONSE: Jain in at least paragraph [0173] discloses the use of product comparisons to personalize the information presented to potential consumers and in Table 2 discloses using an **advertisement(s) of a similar product or the new product** to determine a potential consumer's inclination to buy the product (Customer Nicholas) and the use of an **advertisement highlighting the two attributes** that Customer Joe considers important.

Customers Maria and George are presented with **advertisements highlighting a product attribute and the value of that attribute.**

(10c) Claims 3, 4, 8, 9, 12, 13, 19 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Jain and Zawilinski (US Patent 5,676,138).

Appellant argues *"Zawilinski is cited for allegedly teaching 'a computerized multimedia system for measuring, analyzing, storing, and displaying emotional responses elicited by humans when resented a stimulus such as a television commercial (acknowledging it does not involve still images), but suggests that 'one of ordinary skill to be motivated to combine Jain's marketing research activity with Zawilinski's multimedia stimuli and response analyzer to obtain a better indicator of a customer's response to various product or their features.'* But even assuming *arguendo* this was a proper combination, this still would not result in a combination where *'plurality of intermediate visual presentations of products are still images' and/or 'are at least one of moving images and animations.'"*

EXAMINER'S RESPONSE: Jain in at least paragraphs [0024 through 0028] discloses that the predefined objectives of the invention includes the use of a customer's response to research design and in paragraph [0032] further discloses using the participant's historical responses to said research designs to determine the

probability that the customer will respond to a given incentive. Jain in at least paragraphs [0040 and 0048] further discloses using the customer's response to advertisements as being a part of the invention's research design.

Zawilinski in at least Column 3, lines 41- 62 discloses a multimedia computerized system for measuring, analyzing, storing and displaying emotional responses elicited by one or more human beings, who are being or having been presented a stimulus such as a television commercial. The invention further being capable *of visually displaying one or more stimuli* presented at a given time interval.

Zawilinski in at least Column 4, lines 47-50 further discloses that the object of the invention is to provide a means to detect human emotional response to a stimulus at the time the stimulus is presented. Zawilinski in at least Column 4, lines 55-57 further discloses that the emotional response can be semantically described automatically upon detection.

Zawilinski in at least Fig.2 and Column 6, lines 36-42 discloses a representative screen with the stimulus.

Therefore, it would be obvious, at the time of the invention, to one of ordinary skill to be motivated to combine Jain's marketing research activity with Zawilinski's multimedia stimuli and response analyzer to obtain a better indicator of a customer's response to various products and/or their features.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to

reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Paul Danneman/

Examiner, Art Unit 3627

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/

Director, TC 3600

Conferees:

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627

Vincent Millin /vm/

Appeals Practice Specialist